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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,626	11/26/2003	Keith Yeats	ACO2758US1	7113

7590 07/19/2004
Lainie E. Parker
Akzo Nobel Inc.
Intellectual Property Department
7 Livingstone Avenue
Dobbs Ferry, NY 10522

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/722,626	YEATS ET AL.	
	Examiner	Art Unit	
	Margaret G. Moore	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 to 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 to 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11 to 16 and 19 to 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaki et al.

Yamaki et al. teach a coating composition that contains an acrylic polymer having glycidyl functional groups (see column 4, lines 40 to 57) as well as the alkoxysilyl group found required by instant claims 13, and a linear polysiloxane diol (see column 4, line 62). The bottom of column 10 further teaches the polysiloxane. Note that the preferred lower limits of 10 and 20 for "n" will result in a polysiloxane that meets the claimed molecular weight requirement (since each "n" unit has a molecular weight of 75). Also note component C-1 on column 20 that meets the molecular weight requirement for the polysiloxane in claim 11. Component (E) in Yamaki et al. meets the claimed hardener. Thus, while Yamaki et al. anticipate each of the required components in claim 11, they fail to teach that the composition has more than 70% by weight solids. For the reasons that follow, the Examiner is of the position that such a composition would have been obvious to one having ordinary skill in the art.

First note that the Summary of the Invention and claim 1, which define the prior art composition, do not require *any* solvent for the composition. The Examiner acknowledges that component (A) is a silica dispersed oligomer solution which will inherently contain a solvent but this amount of solvent as found on column 7, lines 15 to 25, combined with the amount of (A) in the final composition as found on column 12, lines 45 to 65, is not sufficient to result in a final composition that is outside the claimed weight solids range. Note that column 13, lines 32 to 35, teaches that the composition can *optionally* be diluted with various organic solvents. Note too that columns 8 and 9 do not indicate that the acrylic resin must be used in a solvent system and column 10 does not indicate that the polysiloxane must be used in a solvent system. Patentees

specifically teach that component (A) is used in a solvent system. The fact that (B) and (C) are not specifically taught to be used in a solvent system indicates that this is optional. Since patentees do not require any solvent in the composition (again with the exception of that which will be in component (A), an amount that is not enough to result in a composition having less than 70% by weight solids) one having ordinary skill in the art would have found this limitation to have been obvious over the teachings of Yamaki et al.

On the other hand, note column 13, lines 50 to 52. This states that, when a solvent is present, the ratio to be diluted may be suitable determined. This indicates that it is within the skill of the ordinary artisan to adjust the amount of solvent, and thus adjust the solids content, of the composition. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Furthermore, in view of the desirability of eliminating or reducing potentially hazardous or unfriendly solvents, the skilled artisan would have been motivated to decrease the amount of solvent in the composition. In this manner too one having ordinary skill in the art would have found a composition that falls within the claimed solids content to have been obvious and within routine experimentation and/or optimization of the teachings of Yamaki et al.

For these reasons one having ordinary skill in the art would have found a composition having a solids content within the claimed range to have been obvious over the teachings of Yamaki et al.

With regards to claim 12, this is a product by process claim. The process limitations per se do not appear to result in an inherently different product and as such they fail to distinguish the claimed glycidyl functional acrylic polymer from that found in the prior art. Regarding claims 14 to 16, note column 8, lines 20 to 30, which teach that butyl acrylate can be used in the acrylic polymer. Also note the acrylic copolymer prepared in the working examples, which differ from that claimed only in that they contain butyl *meth*acrylate rather than butyl acrylate. Such a difference, however, would have been obvious over the teachings on column 8 that the reactive monomers can be (meth)acrylates, implying their functional equivalence. With regards to claims 19 to 21,

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note column 13, which teaches applying the coating to a substrate and that the composition can be cured at room temperature.

3. Claims 17 and 18 are neither taught nor suggested by the teachings in Yamaki et al. as they fail to adequately suggest a composition having the required solids content in combination with the amounts of each component as required by these claims. The Examiner notes that Yamaki et al. broadly embrace such ranges, but fail to provide adequate motivation such that one having ordinary skill in the art would have found the selection of such ranges, within the claimed solids content, to have been obvious.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 11 to 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 18 of copending Application No. 09/888,696. Although the conflicting claims are not identical, they are not patentably distinct from each other because the alkoxysilyl acrylic polymer in '696 embraces the glycidyl functional acrylic polymer required by the instant claims since glycidyl acrylates are operable monomers in the preparation of the acrylic polymer in '696.

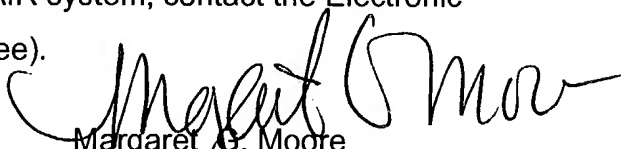
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Eklund et al. is cited as being of general interest, as this powder coating composition is not an ambient temperature curing composition. Vasta is cited as being of general interest, as this composition fails to specifically show a polysiloxane meeting the formula required.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
7/15/04